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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,806	10/16/2003	Bryan V. Hunt	86266AJLT	9649

7590 06/28/2005

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EXAMINER	
CHEA, THORL	
ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/686,806	HUNT ET AL.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to provide support for the limitation " a photosensitive silver halide that is spectrally sensitized to the infrared region of the spectrum". The specification on page 10, pointed out by the applicant discloses "The photothermographic materials are sensitive at ultraviolet, visible, infrared, or near infrared wavelengths, of the electromagnetic spectrum"; page 53, lines 6-10 discloses Particularly useful infrared exposure means include laser diodes, that are modulated to increase imaging efficiency using what is known as multi-longitudinal exposure techniques as describes in US Patent No. 5,780,207. There is no process of spectrally sensitize the photosensitive silver halide in the infrared region of the electromagnetic spectrum disclosed therein. Therefore, the limitation as claimed raises the issue of new matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 4-9, 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Toya (US Patent 5,698,380).

See Toya columns 15-21, examples 2, antihalation dye I-1 and spectral sensitizing dye [1], the exposure wavelength of 780 nm which is within the infrared region of the electromagnetic wavelength. Toya may not state specifically that "the value for b* at an optical density of 1.0 is greater than the value of b* at Dmin" presented in the claimed invention. However, the b* value is related to the material after processing. This value would be inherent to the material of taught Toya because of the similarity of the composition. The total absorbance of at least 1.0 an exposure wavelength is small enough to be inherent to the material of Toya. See Toya in column 16 wherein Dye I-1 is coated within an amount of 10 mg/m^2. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

6. Claims 10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toya as applied to claims 1 4-9, 11 above, and further in view of Murray (US Patent No. 5,705,324) and Manian (US Patent No. 5,172,419).. The process having steps presented in the claims invention

is taught in Murray in column 23-24, claims 9,19. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to develop the material taught in Toya with a known process taught in Murray to provide the claimed invention. The method of digitizing a medical film image has been known in Manian. See abstract and columns 6-10, claims 1-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to form an image using a digitizing means taught in Manian to produce medical film, and thereby provide a process as claimed.

7. Claims 1, 4-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsuzuki (US Patent 5,677,121).

See Tsuzuki columns 19-23, examples 1-2, wherein the photographic material is sensitive to light of 810 nm which is within the infrared region of the electromagnetic wavelength, and the material contains an infrared dye and an antihaltion dye. See for instance examples 22 in column 22, (Dye 2) and (Dye 3) to (Dye 5) in column 23-24. Toya may not state specifically that "the value for b* at an optical density of 1.0 is greater than the value of b* at Dmin" presented in the claimed invention. However, the b* value is related to the material after processing. This value would be inherent to the material of taught Toya because of the similarity of the composition. The total absorbance of at least 1.0 an exposure wavelength is small enough to be inherent to the material of Toya. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

8. Claims 10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuzuki as applied to claims 1 4-9, 11 above, and further in view of Murray (US Patent No. 5,705,324)

and Manian (US Patent No. 5,172,419). The process having steps presented in the claims invention is taught in Murray in column 23-24, claims 9,19. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to develop the material taught in Tsuzuki with a known process taught in Murray to provide the claimed invention. The method of digitizing a medical film image has been known in Manian. See abstract and columns 6-10, claims 1-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to form an image using a digitizing means taught in Manian to produce medical film, and thereby provide a process as claimed.

9. Claims 1, 4-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katoh (US Patent No. 6,146,823)

See Katoh columns 39-45, examples 1 wherein the e exposure wavelength of 780 nm which is within the infrared region of the electromagnetic wavelength (column 44, lines 47-68), and in column 16, lines 1-14 which discloses the use of dyestuff to provide a photothermographic material at least 0.8 at the exposure wavelength of 750 nm to 1500 nm. Katoh may not state specifically that "the value for b* at an optical density of 1.0 is greater than the value of b* at Dmin" presented in the claimed invention. However, the b* value is related to the material after processing. This value would be inherent to the material of taught in Katoh because of the similarity of the composition. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

10. Claims 10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh as applied to claims 1 4-9, 11 above, and further in view of Murray (US Patent No. 5,705,324)

and Manian (US Patent No. 5,172,419). The process having steps presented in the claims invention is taught in Murray in column 23-24, claims 9,19. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to develop the material taught in Katoh with a known process taught in Murray to provide the claimed invention. The method of digitizing a medical film image has been known in Manian. See abstract and columns 6-10, claims 1-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to form an image using a digitizing means taught in Manian to produce medical film, and thereby provide a process as claimed.

Response to Arguments

11. Applicant's arguments filed March 24, 2005 have been fully considered but they are not persuasive due to the new ground of rejection set forth in the rejections above. The b* value which characterizes the toning of the developed photothermographic material is inherent to the process of developing the material or the material after processing, rather than characterize the characteristic of the material before processing.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1700.

Tch
June 24, 2005

Thorl Chea
Primary Examiner
Art Unit 1752